

REMARKS

This paper responds to the Office Action mailed on June 9, 2005. Claims 1, 5 and 6 are amended such that claims 1, 3, 5-6, 8-16, 18, 22 and 25-27 are now pending in this application.

Pending claims 25-27

Applicant notes that pending claims 25-27 are not addressed in the Office Action. Claims 25-27 are not allowed or rejected. Clarification is respectfully requested.

Allowable Subject Matter

Claims 16, 18, 22 have been allowed.

§112 Rejection of the Claims

Claims 5 and 6 were rejected under 35 U.S.C. § 112, second paragraph, as lacking adequate description or enablement. Applicant has amended claims 5 and 6 such that claims 5 and 6 each depend from pending claim 1.

Reconsideration and allowance of claims 5 and 6 are respectfully requested.

§102 Rejection of the Claims

Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) for anticipation by Ikeda et al. (US 4,925,743). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. '2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant can not find in Ikeda any teaching or suggestion of “a cover layer that is attached to said reflective layer to form an enclosure that contains said heat source” as recited in amended claim 1. Applicant respectfully directs the Examiner’s attention to col. 3, lines 40-51,

and FIGS. 1 and 2 of Ikeda which describe placing a reflecting means 3 onto an enclosure such that the reflecting means 3 does not form part of the enclosure. Since the reflecting means 3 in Ikeda does not form part of enclosure, Ikeda does not teach or suggest sealing a heat source inside an enclosure that is formed of a cover layer and a reflective layer. Applicant respectfully requests that the Examiner cite with particularity where Ikeda describes an enclosure that contains a heat source where the enclosure is formed of a cover layer and reflecting layer.

Claim 3 depends from claim 1 such that claim 3 incorporates all the limitations of claim 1. Therefore, Ikeda does not appear to describe the subject matter of claim 3 for the reasons provided above with regard to claim 1 (among other reasons).

Reconsideration and allowance of claims 1 and 3 are respectfully requested.

§103 Rejection of the Claims

Claims 1, 3, 5-6 and 8-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burkett et al. (US 5,918,590) in view of Ikeda et al. ('743). A *prima facie* case of obviousness has not been established against claims 1, 3, 5-6 and 8-15 because (i) Ikeda and Burkett do not disclose either singularly, or in combination, the invention as recited in claims 1, 3, 5-6 and 8-15; and (ii) there is no reason or motivation to combine Ikeda and Burkett.

I. Ikeda and Burkett Do Not Teach or Suggest Every Element of Claims 1, 3, 5-6 and 8-15

Claims 1, 3, 5-6

Applicant can not find in Ikeda and/or Burkett any teaching or suggestion of “a reflective layer that reflects infrared energy emitted by the body back into the body” in combination with “a cover layer that is attached to said reflective layer to form an enclosure that contains said heat source” as recited in amended claim 1. The Examiner acknowledges at page 3 of the Office Action that the reflecting means 3 described in Ikeda is placed onto the enclosure and does not form part of the enclosure by stating “Ikeda et al. disclose . . . a heating device . . . that comprises a reflective layer . . . attached to the enclosing layer (2).”

In addition, that Examiner acknowledges at page 3 of the Office Action that “Burkett et al. lack the specific disclosure of a reflective layer that reflects infrared energy emitted by the

patient's body and that is attached to the heat source." Therefore, the cited combination does not teach or suggest sealing a heat source inside an enclosure that is formed of a gas-permeable layer and a reflective layer.

Claims 3 and 5-6 depend from claim 1 such that claims 3 and 5-6 incorporate all of the limitations of claim 1. Therefore, Burkett and/or Ikeda do not appear to describe the subject matter of claims 3 and 5-6 for the reasons provided above with regard to claim 1 (among other reasons).

Claims 8-15

Applicant can not find in Ikeda and/or Burkett any teaching or suggestion of "an enclosure that includes a gas-permeable layer and a reflective layer attached to said gas-permeable layer" in combination with "a heating composition sealed inside said gas-permeable layer and said reflective layer" as recited in claim 8. As discussed above, the Examiner acknowledges at page 3 of the Office Action that (i) the reflecting means 3 described in Ikeda is placed onto the enclosure and does not form part of the enclosure; and (ii) Burkett lacks any description as to a reflective layer. Therefore, the cited combination does not teach or suggest sealing a heating composition inside an enclosure that is formed of a gas-permeable layer and a reflective layer.

Claims 9-15 depend from claim 8 such that claims 9-15 incorporate all of the limitations of claim 8. Therefore, Burkett and/or Ikeda do not appear to describe the subject matter of claims 9-15 for the reasons provided above with regard to claim 8 (among other reasons).

II. There is No Motivation or Suggestion to Combine Ikeda and Burkett

As part of making the rejection, the Examiner states at page 4 of the Office Action that "at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Burkett et al., as taught by Ikeda et al. to provide a reflecting layer that provides the advantage of reflecting infrared wavelengths to minimize the loss of radiation to the enclosure." Applicant respectfully traverses this assertion in part because Applicant can not find any teaching or suggestion in Burkett relating to using a reflective layer.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). Applicant respectfully submits that the statement made by the Examiner regarding a motivation to combine Ikeda and Augustine is a mere conclusory statement of subjective belief because the statement is analogous to the statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

“With respect to Lee’s application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner’s conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully requests that the Examiner cite with particularity some support for the assertion relating to motivation which was made in the Office Action. Applicant respectfully notes that the only teaching relating to sealing a heat source inside an enclosure that is at least partially formed of a reflective layer is found in Applicant’s disclosure.

Applicant further notes that a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484

(1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Applicant notes that Ikeda appears to teach away from Burkett because Ikeda teaches away from using any of compositions disclosed in Burkett (see, e.g., column 1, lines 30-50 of Ikeda). Applicant respectfully submits that upon reading Ikeda one of ordinary skill in the art would be discouraged from looking to Burkett such that there is no motivation to combine Ikeda with Burkett.

Reconsideration and allowance of claims 1, 3, 5-6 and 8-15 are respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of June, 2005.

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